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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/068,843	02/11/2002	Masanori Mukai	1080.1108	8975

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EXAMINER

RODRIGUEZ, JOSEPH C

ART UNIT

PAPER NUMBER

3653

DATE MAILED: 12/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/068,843

Applicant(s)

MUKAI, MASANORI

Examiner

Joseph C Rodriguez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Specification*

The abstract of the disclosure is objected to because of improper language.

Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. *It should avoid using phrases which can be implied*, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitations "the one process" (ln. 7, 20-21), "the start of one process" (ln. 16), "the initial detecting process" (ln. 24). There is insufficient antecedent basis for these limitations in the claim. Further, these limitations can be found throughout the claims and also lack antecedent basis thereat.

Claim 3 recites the limitation "the discriminating route" (last ln.). There is insufficient antecedent basis for this limitation in the claim.

Claim 8 recites the limitation "the sensor output error detecting portion" (ln. 3-4) and "the mock papers" (ln. 8, 18). There is insufficient antecedent basis for these limitations in the claim.

Claim 9 recites the limitation "the passing area" (ln. 6-7, 18). There is insufficient antecedent basis for this limitation in the claim.

Further, the claim language "[a] paper processing device which comprises" (ln. 1) and "the paper processing device comprising" (ln. 12) renders the invention unclear as it is uncertain if the first descriptive portion is meant merely as a preamble, or otherwise. Examiner requests clarification.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2 and 4-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Sugai et al. ("Sugai")(US '249).

Sugai teaches a paper processing device (Fig. 1-20) comprising a discriminating portion with sensors (313a-313g, 312a-312g), transfer routes (near 309-311), a sensor output abnormality detecting portion (331, 332), and a transfer control portion (330).

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Here, the transfer route corresponding to the specified abnormal status can be regarded as the normal dispensing or depositing route as the device continues operation although an abnormal sensor has been detected as the use of alternate sensors, or the subsequent cleaning of the sensors, allows continued operation (col. 18, ln. 36 et seq.).

Regarding claims 2 and 4-6, these claims merely consist of functional language and, moreover, the device taught by Sugai is regarded as capable of functioning as claimed. Applicant is respectfully reminded that claim language consisting of functional language and/or intended use phrasing is given little, if any, patentable weight as the apparatus must merely be capable of functioning, or being used, as claimed. See MPEP 2112.02, 2114. Further, the object worked upon by an apparatus (i.e., mock papers) does not render an apparatus patentable. See MPEP 2115.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sugai in view of what is well known in the art as demonstrated by Goto et al. ("Goto") (JP '456) and Applicant's Admissions.

Sugai as set forth above teaches all that is claimed except for expressly teaching using a line sensor as the discriminating sensor. This feature, however, is well-known

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in the paper processing arts. For instance, Applicant (Spec., p. 1) and Goto (Abstract) teach the use of a line sensor when distinguishing papers during processing. Moreover, these sensors offer finer measurements than traditional optical sensors. Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention of Sugai as taught above.

Claims 1 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ono et al. ("Ono")(US '937) in view of Nei et al. ("Nei")(JP '984).

Ono (col. 7, ln. 18-col. 8, ln. 45) teaches all that is claimed except for expressly teaching the continued operation of the device during abnormal sensor detection by using a pool portion to temporary hold the abnormal papers. Nei, however, teaches the use of a pool portion (i.e., temporary holding portion 42-44) and, moreover, expressly teaches that this feature allows for the continued operation of the device during machine malfunctioning (Abstract). Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the abnormal sensor detection system of Ono with the pool portion taught by Nei to eliminate the device processing down time normally experienced during abnormal sensor detection (i.e., malfunctioning) in Ono's device.

### ***Conclusion***

Any references not explicitly discussed above but made of record are considered relevant to the prosecution of the instant application.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph C Rodriguez whose telephone number is 703-308-8342. The examiner can normally be reached on M-F during business hours, with alternate Mondays off.

The fax phone number for the organization where this application or proceeding is assigned is 703-306-4195.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

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December 6, 2002

  
DONALD E. WALSH  
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